

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	Bruce L. Kennedy
Application No. 10/662,599	Filing Date: September 15, 2003
Title of Application:	Video Recording and Image Capture Device
Confirmation No. 2356	Art Unit: 3739
Examiner	Philip R. Smith

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Reply Brief Under 37 CFR §41.41

Dear Sir:

Having received the Examiner's Answer, Appellant submits this Reply Brief for the above-captioned application pursuant to 37 C.F.R. §41.41 as follows.

Most of the arguments presented in the Examiner's Answer were presented during prosecution, and thus, have already been dealt with in Appellant's Appeal Brief. Appellant submits this Reply to briefly elaborate on new or expanded issues raised in the Examiner's Answer.

The examiner has provided supplemental arguments / responses relating to the various combination of references, which Appellant responds to in this Reply Brief.

Rejections under 35 U.S.C. §112, paragraph one

With respect to the examiner's rejection of claims 24 and 25 under 35 U.S.C. §112, paragraph one, the examiner has submitted that "the word 'hinge' has no special meaning in the art of medical technology, and Appellan provides no evidence that a hinge should be given anything but its plain meaning.¹ Additionally, the examiner has submitted that "Examiner maintains that hinges having the recited function are not known in the relevant art. Moreover, Appellant provides no evidence that such hinges are known in any art, relevant or otherwise.

Claim 19 recites, in part, "said touch screen movable between a first position at least partially within a footprint of said housing and a second position extended from said footprint of said housing, said touch screen deflectable about an axis of said housing." Claim 24 recites, in part, "said touch screen is easier to deflect in one direction than in the other direction"; while claim 25 recites, in part, "said touch screen is more difficult to deflect in the opening direction than in the closing direction."

First, Appellant submits that the examiner's arguments defining the term "hinge", should be discarded as this term is not recited in the claims. The term "hinge" is used in the specification, for example, "hinge 142" is depicted in the drawings and described in the written specification. ¶59; FIGS. 14a & 14b. However, the term "hinge" is not recited in any of claims 19, 24 and 25.

Second, with regard to the examiner's statement that "hinges having the recited function are not known in the relevant art", Applicant submits that these types of devices for medical applications are notoriously well-known in the industry. For

example, a company named Reel Precision Manufacturing Corporation manufactures such a device, which is described in U.S. Patent No. 6,561,333.²

Rejections under 35 U.S.C. §103(a)

Claim 19

Claim 19 recites “A medical video instrument having touch screen control comprising . . . a housing for enclosing said processor, said touch screen movable between a first position at least partially within a footprint of said housing and a second position extended from said footprint of said housing, said touch screen deflectable about an axis of said housing.”

In response to Appellant’s arguments, the examiner has submitted “the correct question is . . . whether it would have been obvious to provide a video display in a ‘housing,’ according to the broadest reasonable interpretation of the term.” Examiner’s Answer, p. 13. The examiner then goes on to state that “the ‘housing’ of claim 19 is certainly furniture in the broadest reasonable interpretation of the word”, which he again defines according to “www.merriam-webster.com/dictionary/furniture.” Examiner Answer, p. 14. Appellant submits that this interpretation is not reasonable. Claim 19 is to a “medical video instrument . . . comprising . . . a housing.” To say that the box that contains the video processing electronics is “furniture” is not reasonable. This is especially true where, rather than look to Rosen (the cited reference) to see what the inventor if Rosen meant, the examiner has to look to other sources to support his strained reading of “furniture.” Rosen is clear teaching “a video display configured for storage within an edge of a table or counter, particularly in locations where space is li-

¹ The examiner has submitted that the plain meaning of the term “hinge” as used in the pending application should be taken from the Dictionary.com webpage. Examiner’s Answer, p. 10.

² One example of such a device is described on the Reel Precision Manufacturing Corporation website, which says “In high-torque vertical mounting applications, the MH15’s asymmetric torque design allows for *easy upward adjustment without compromising holding force in the downward direction*. The

mitted. For example, such a video display would be useful in recreational vehicles, campers, buses and boats, where space is at a premium, but where video displays are often used.” ¶12 The examiner takes the teaching of “an edge of a table or counter” and expands it to “furniture” and then looks to an online dictionary to further expand that term in an attempt to equate “an edge of a table or counter” with the “housing” of a “medical instrument.”³ The examiner’s expansive reading of the term “housing” is not supported by the pending application nor the cited prior art and is simply not reasonable.

While Applicant acknowledges that during patent examination, the pending claims are to be “given their broadest reasonable interpretation consistent with the specification”, Applicant points out that the Examiner is not without constraint in his/her interpretation of claim elements. Indeed, the Federal Circuit has expressly recognized the “broadest reasonable interpretation” standard is limited in that the claim limitation must be interpreted as it “would be interpreted by one of ordinary skill in the art.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004); *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.). Thus, simply because the Examiner may want to call the medical instrument housing of claim 19 “furniture” into which the device of of Rosen is installed in order to establish a claim rejection, such is improper if one skilled in the art would not interpret the housing to be “furniture.”

In response to Appellant’s arguments that there is no teaching in Beutter that it would be advantageous to combine the separate “camera control unit 34” and separate “monitor 36” into a single device, the examiner has submitted that it “is not clear what

MH15 is also available in standard symmetric torque configuration for doors and other horizontal mounting applications.” <http://www.reell.com/index.php?page=reell-mh15> (emphasis added).

³ The examiner has submitted that “Rosen’s stowable display is not restricted to use of the countertop or a camper or recreational vehicle . . . a ‘housing’ – in the broadest reasonable interpretation of the term – is an article of furniture.” Examiner’s Answer, pp. 14-15.

'single device' Appellant is referring to, or why such a combination is necessary to meet the limitations of claim 19." Examiner's Answer, p. 15. Appellant submits that claim 19 recites, in part, a "medical video instrument having touch screen control comprising . . . a housing for enclosing said processor, said touch screen movable between a first position at least partially within a footprint of said housing and a second position extended from said footprint of said housing, said touch screen deflectable about an axis of said housing." Accordingly, to meet the limitations of claim 19, the touch screen has to be attached to the housing in some manner so that it is movable between two different positions with respect to the housing and is "deflectable about an axis of said housing."

There is no teaching in either reference that the system taught in Beutter should be so modified according to claim 19, and in fact, Beutter teaches that these are advantageously separate. The examiner provides little if any evidence to the contrary. The examiner simply makes the statement that "Rosen discloses and advantageous arrangement wherein a display is stowable within a footprint of the structure to which it is mounted." Examiner's Answer, p. 15 (emphasis added).⁴ The examiner provides essentially no evidence to support his position. Rather, the examiner even appears to understand that Rosen discloses and teaches a "structure" (e.g. "an edge of a table or counter") into which the television set of Rosen can be folded and not the housing or box of the medical instrument of claim 19.

Claim 20

Claim 20 recites the "medical instrument of claim 19 in which said touch screen is unpluggable from said housing."

In response to Appellants arguments that none of the cited references teach or disclose this limitation, the examiner states "Examiner maintains that the display is inhe-

⁴ The examiner further makes the conclusory statement that it would be obvious "to provide a medical video instrument where the touch screen display is stowable within a footprint of the structure to which it is mounted." Examiner's Answer, p. 15 (emphasis added).

rently “unpluggable” from the generic structure (“utility structure 12”) to which it is mounted.” Examiner’s Answer, p. 15. Accordingly, the examiner has declined to provide any evidence whatsoever to support this assertion other than to argue inherency.

The entire premise of an inherency argument is that the limitation is “necessarily present” as there is no other way the system could function. *Cont’l Can Co. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). The device of Rosen is installed in the counter or desk top of furniture. Appellant submits that such a device can be installed with, for example, screws, bolt/nuts, or other fastening devices that permanently fasten the device to the counter top. There is no teaching that the device is provided in some sort of arrangement where the device can simply be detached by sliding or pulling the device out of the counter top. If it is the examiner’s position that “unpluggable” means that the device could be removed from the counter by, for example, disassembling the device by unscrewing screws or bolts/nuts, etc., this is an unreasonable interpretation. For example, under this interpretation, a car door would be “unpluggable” from a car.

Again, the Federal Circuit has expressly recognized the “broadest reasonable interpretation” standard is limited in that the claim limitation must be interpreted as it “would be interpreted by one of ordinary skill in the art.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004); *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.). There is no teaching or disclosure that the device of Rosen installed in the counter top is “unpluggable.”

Claim 21

Claim 21 recites the “medical instrument of claim 19 in which said housing and said touch screen include stackable mating plug portions.”

The examiner has stated that the "Examiner has interpreted the 'stackable mating plug portion' as elements that (i) 'connect' the touch screen in some physical or conceptual sense to a video interface; and (ii) are depictable as boxes in a block diagram. The touch screen of Buetter is certainly connected to the 'camera control unit 34', and that connection is inherently depictable as boxes in a block diagram." Examiner's Answer, p. 17.

Again, the Federal Circuit has expressly recognized the "broadest reasonable interpretation" standard is limited in that the claim limitation must be interpreted as it "would be interpreted by one of ordinary skill in the art." *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004); *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.). The examiner provides no explanation as to how the connection between the display and control unit of Beutter can be interpreted as "stackable."

Likewise, the fact that examiner states that this "is the first time that Appellant has attempted to imply a connection between a Storz Communication Bus and the 'stackable mating plug portions 151a, 151b'" should be discounted as the originally filed application included (and the examiner does not dispute this) disclosure relating to the "stackable mating plug portions" (originally filed claim), the network and communication bus, and the "vertically stacked IDE bus 116." ¶11, 48-49 & 70; FIGS.

Appellant further submits that Appellant is not attempting to limit the term "stackable mating plug portions" to only be limited to a "vertically stacked IDE bus 116." However, Appellant referred to this portion of the specification to provide evidence that the specification does provide direction to one of skill in the art that the term "stackable mating plug portions" would be directed to a configuration where the medical instrument may be stacked with, for example, another medical instrument and connected to a "bus"

for communication. Accordingly, Appellant has not submitted nor is there any "limiting relationship between elements '116' and '151a, 151b.'" as the examiner states, rather, the specification provides insight as to what one of ordinary skill in the art would understand the term "stackable mating plug portions" and would include at the least, the ability to stack on instrument on another and mate via the plug portions. Beutter fails to teach or disclose this.

Claim 22

Claim 22 recites the "medical instrument of claim 20 in which said touch screen can be used by a plurality of medical instruments."

The examiner has submitted that "a touch screen is inherently capable of being used by a plurality of medical instruments. It is impossible to imagine a touch screen that is *not*." Examiner's Answer, p. 18.

As an initial matter, the comment by the examiner that it "is impossible to imagine a touch screen that is *not* [capable of being used by a plurality of medical instruments]" should be discounted. The touch screen cited by the examiner is the touch screen taught in Beutter, not any touch screen ever invented including those used today some eight years after the filing of this application.

The premise of an inherency argument is that the limitation is "necessarily present" as there is no other way the system could function. *Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). Beutter teaches that the touch screen is only used to control the endoscopic viewing system. Nowhere does Beutter teach that the touch screen used in Beutter "can be used by a plurality of medical instruments." For example, Beutter states,

A surgeon may regulate the image of the surgical site displayed by the endoscopic viewing system 20 with an operating room control center 42. In response to touch-screen or voice generated commands, the operating room control center

42 generates control signals to the camera control unit 34. Based upon signals received from the control center 42, the camera control unit 34 sets the lenses internal to the coupler 38 for the appropriate level of magnification. Alternatively, based on commands received from control center 42, the camera control unit 34 will reset the lenses to refocus the image presented to the transducer 29 or to be appropriately positioned. Based upon the received control center commands, camera control unit 34 will also process the signals received from the camera head transducer 29 to digital enhance, focus and/or selectively enlarge the final version of the captured image that is presented on monitor 36. [0030]

Referring to FIGS. 11-13, operation of the endoscopic viewing system 20 is described. FIG. 11 represents response of the endoscopic viewing system 20 to a command to magnify, zoom in on, the surgical site. Recall that the control center 42 disclosed herein can receive either touch-screen or voice generated commands. However, the coupler 38 of this invention could be utilized with a control center that receives commands in any suitable manner. In addition, at any time during the execution of a command, the surgeon can give a stop command, thus preventing the control center 42 from completing the action. [0065]

In addition, while the endoscopic viewing system 20 has been described for use with a control center 42 that can receive both touch-screen and voice commands, the present invention is not limited to those such a viewing system. For instance, the zoom and focus commands could also be input via movement of one or more switches or pedals that are operably connected to the control center 42. [0087]

(emphasis added). Every example in which the touch screen is discussed only teaches controlling of the viewing system, not "a plurality of medical instruments."

In response to Appellant's arguments regarding the limited uses of taking Official Notice, the examiner has declined to provide any evidence whatsoever to support his position and instead, has argued inherency. However, as shown above, Beutter itself refutes this argument as Beutter teaches that the touch screen is limited to controlling the endoscopic viewing system. There is no evidence that additional medical equipment could be plugged into the touch screen and these could then be operated by the touch screen.

Conclusion

For the foregoing reasons, Applicant respectfully submits that the claimed invention embodied in each of claims 19-22, 24-31, 46 and 48-49 is patentable over the cited prior art. As such, Applicant respectfully requests that the rejections of each of claims 19-22, 24-31, 46 and 48-49 be reversed and the Examiner be directed to issue a Notice of Allowance allowing each of claims 19-22, 24-31, 46 and 48-49.

Respectfully submitted,

November 8, 2011

/Wesley W. Whitmyer, Jr./

Wesley W. Whitmyer, Jr., Registration No. 33,558
Steven B. Simonis, Registration No. 54,449
Attorneys for Applicant
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155